

Application No. 10/716,181
Response to January 29, 2009 Office Action
Attorney Docket No.: F132

Remarks/Arguments

Claims 1-46 are pending in the application. Claims 9-14, 25, 33, and 40-41 are cancelled by this amendment. Claims 1, 15, 24, 39, and 42 are in independent form.

Claims Rejections under 35 U.S.C. § 112

Claims 1-39 are rejected under 35 U.S.C. § 112 as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, most of the rejected claims are rejected for using the word "closely," while the rest were rejected for using the word "slightly." According to the Examiner, each of these words is "a relative term that lacks basis for comparison." As explained in Applicants' Response to the Office Action of Sept. 17, 2007, and repeated below, Applicants disagree. It is well established that the use of terms of degree like "closely" and "slightly" are permissible in patent claims. Further, the language of the rejected claims, especially when considered in the light of the explanation of the invention provided in the specification, very clearly describes the limitations at issue and their relationship to the other components of the claimed invention. Thus, contrary to the Examiner's rejection, the terms do provide "basis for comparison."

Nevertheless, in the interest of advancing prosecution in this case, Applicants hereby submit claim amendments substituting the term "match" (which is used throughout the specification) for the objected to term "closely approximates." Although this amendment is made after final, no new matter is added by way of this amendment, and no new search will be required by the Examiner because the amendment does not change the scope of the claims. Applicant notes that the two terms are used as equivalent in the specification. Applicant further notes that the

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Examiner has suggested the use of the term "matching" in his response to Applicants' arguments. Thus, the amendment should be allowable under § 714.12(b)(1) of the MPEP because the amendment complies with a requirement of form expressly set forth in a previous Office action. Applicants also note that the amendments, by removing the Examiner's § 112 rejections also place the application in better form for consideration on appeal should the claims not be allowed by the Examiner. See MPEP § 714.12(b)(2).

Finally, as discussed below, Applicants believe that the final rejection in this case was not proper because the Examiner continues to rely upon a reference that is not prior art under § 103(a).

As a result, in order to maintain the rejections found in the most recent Office Action, the Examiner would have been required to produce a new reference showing the limitations in the rejected claims and make the most recent Office Action a non-final rejection. Therefore, in the alternative, Applicants request that the Final Office Action be withdrawn and replaced with a Non-final Office Action.

This requested amendment of the claims does not indicate intent by Applicants to concede on this issue. Applicants maintain their traverse of this rejection, and should the amendment be denied Applicants reserve the right to pursue this issue on appeal.

Claim Rejections Under 35 USC § 102

Claims 1 and 4-7 stand rejected under 35 USC § 102(b) as being anticipated by Tao et al. (U.S. Patent No. 5,874,010). Applicants note that the Examiner has maintained his § 102 objection even though the Tao reference is completely different than Applicants' invention and does not teach any of the significant limitations in Applicants' claims. In fact, as explained in great

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detail in Applicant's previous responses, Tao teaches a process which is essentially the exact opposite of Applicants' invention. Accordingly, Applicants re-urge the argument presented in their Response to the Office Action of Sept. 17, 2007 and their Response to the Office Action of May 12, 2008, and ask that the § 102 rejections be withdrawn.

Claim Rejections Under 35 USC § 103

Claims 2, 3, 8, 8-14, 24-38 and 42-46 stand rejected under 35 USC § 103(a) as being unpatentable over Tao et al. (U.S. Patent No. 5,874,910) in view of Hong et al. (U.S. Patent No. 6,198,608). Applicants submit that the rejected claims all contain limitations which are not described or taught by the cited references. As is the case with the Tao reference discussed above, the portions of the Hong reference cited by the Examiner do not teach any of the limitations found in Applicants' claims. Like Tao, Hong teaches a slow ion-milling layer that serves as a mask during the milling process. This is virtually the opposite of the process claimed by Applicants. The rejected claims teach an overlayer with a mill rate that matches the mill rate of the substrate. Both Hong and Tao teach a process with a mask layer which mills at a much slower rate than the substrate. As discussed in great detail in Applicants' Specification, the process described by Tao and Hong would result in a large degree of curtaining, rather than the uniform planar face produced by Applicants' invention and required by the rejected claims. Accordingly, Applicants re-urge the argument presented in their Response to the Office Action of Sept. 17, 2007 and their Response to the Office Action of May 12, 2008, and ask that the § 103 rejections be withdrawn.

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Claims 15-23 and 39

Claims 15-23 and 39 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Tao et al., in view of Hong and further view of WO 03/019523 to Tasker et al. ("Tasker"). Along with the Response to the Office Action of May 12, 2008, Applicants submitted declarations under 37 §1.131 from all of the co-inventors of the present invention attesting that the present invention was invented prior to the publication date of the Tasker reference. The declarations met all of the requirements of 37 C.F.R. § 1.131 for overcoming the Tasker reference. The Examiner has not addressed the declarations at all in the most recent Office Action, much less raised any objections to the evidence provided by Applicants. Accordingly, Applicants request that the § 103 rejections to claims 15-23 and 39 be withdrawn.

Conclusion

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific objection, issue, or comment does not signify agreement with or concession of the rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicants submit that all claims in the application are now in condition for allowance, and Applicants respectfully request that a timely Notice of Allowance be issued in this case.

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Applicants believe that no fees are due at this time. However, if the Commissioner determines that any additional fees or extensions are required, Applicants request that such extensions be granted and any fees be charged to Deposit Account 50-1635.

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Respectfully submitted,



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